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Election
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AB

PATENT
CASE NO. PD0340K

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Thomas J. Ambrosio et al.

Serial No. 08/446,804 Art Unit: 3307

Filed: June 1, 1995 Examiner: E. Raciti

For: INHALER FOR POWDERED MEDICATIONS

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action mailed on December 20, 1995 for the above-identified application, the applicants respectfully traverse the restriction requirement set forth therein. As this response is being filed within the set thirty-day period, it is believed that no petition or fee is now necessary.

This application is the national phase filing under 35 U.S.C. § 371 of International Application PCT/US93/12076.

The Office Action asserted that the application contains claims to patentably distinct species of dose plates, pawl drives, mouthpiece nozzles, bases and lower spring retainers. It was requested that the applicants elect a single disclosed species of each of these elements, it being contemplated that the claims would be restricted thereto if no generic claim is finally determined to be allowable. The election requirement was predicated on provisions of 35 U.S.C. § 121.

However, the requirement is not consonant with applicable law. Restriction practice is not applicable to applications filed under the Patent Cooperation Treaty, which subsequently enter the U.S. national phase under 35 U.S.C. § 371. M.P.E.P.

§ 801 clearly states that such applications are subject only to the PCT unity of invention requirement. Please see M.P.E.P. § 1895.01(4), which contains a sentence reading as follows:

> Restriction practice under 35 U.S.C. 121, as it applies to national applications submitted under 35 U.S.C. 111(a), is not applicable to either international or national stage applications.

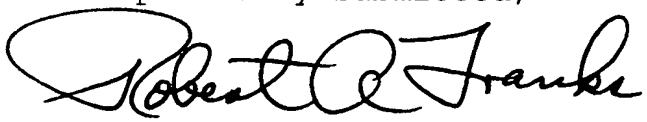
The M.P.E.P. deals with unity of invention solely in Chapter 1800, not in Chapter 800. "Patentably distinct" is not a concept which applies in any manner to examination of the applicants' claims.

As the applicants consider that any requirement imposed on their application under 35 U.S.C. § 121 is contrary to applicable treaty law, which supersedes domestic statutory law, they are not willing to provisionally elect particular species for initial examination.

Reconsideration and withdrawal of the election requirement, and examination of all claims pending in the application, are respectfully requested.

If it is desired to arrange for a telephonic or personal interview to address any matter involving this application, please contact the undersigned.

Respectfully submitted,



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I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE U.S. POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: COMMISSIONER OF PATENTS AND TRADEMARKS, WASHINGTON, D.C. 20231, ON

January 17, 1996

Jan. 17, 1996 Robert A. Franks
(DATE SIGNED)

ROBERT A. FRANKS
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